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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,052	06/26/2001	Wolfgang Fritz	HOE605	1771
7590 05/04/2004			EXAMINER	
Edward J. Timmer Walnut Woods Center 5955 W. Main Street Kalamazoo, MI 49009			COMPTON, ERIC B	
			ART UNIT	PAPER NUMBER
			3726	

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/892,052

Applicant(s)

FRITZ, WOLFGANG

Examiner

Eric B. Compton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 March 0204.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9,11-19 and 22-25 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 9,11-19 and 22-25 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 18, 2004, has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 23 recites the limitation "the additional gasket layer" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 19 and 22-23 are rejected under 35 U.S.C. 102(a) as being anticipated by Applicant's Admitted Prior Art ("AAPA").

AAPA discloses

***The present invention relates to a device for the production of gasket layers for single or multiple layered gaskets from one respective gasket layer section of a starting material comprising several continuous gasket layer sections,*** comprising a follow-on combination tool with several machining stations which follow one another along a direction of feed and in which the gasket layer sections are machined during operating cycles, wherein at least one of the machining stations is designed as a station for cutting outer contour lines, in which facing outer contour lines of two adjacent gasket layers are cut by means of a tool for cutting outer contour lines, and a feeding device, by means of which the gasket layer sections are moved further along the direction of feed by a feed distance  $v$  between two operating cycles.

***Devices of this type are known from the state of the art.***

Specification, page 1 (emphasis added). Furthermore, AAPA states, "The gasket plate 132 produced with the [conventional] follow-on combination tool 114 described above has a rounded, corner-free outer contour and is used as central layer of a three-layered metal gasket 142 illustrated in FIGS. 4 to 6." Specification, page 14. Figure 4, shows a corner formed at the intersection of the contour line and the free cutting line. Regardless of how the other layers are produced, they are nonetheless provided for, having the same structural limitations claimed. Thus, AAPA, inherently discloses gaskets of this type are known in the art.

Note: the method of forming the device is not germane to the issue of patentability of the device itself. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product-by-process claim is the same or obvious from a product of the prior art, the

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claim is unpatentable even though the prior art was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, these limitations have not been given patentable weight.

6. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. 5,582,415 to Yoshida et al. (“Yoshida”).

Claim 19 only requires a gasket comprising: a first layer and a second layer or multiple layers disposed one on the other to form a multi-layered gasket having a contour line and a corner, “wherein said second gasket layer projects beyond the corner on the first layer.”

Yoshida discloses a multi-layered gasket having a first layer (30,31) and a second layer (21) disposed one on the other to form a multi-layered gasket having a contour line and a corner. See e.g., Figure 4. The second gasket layer may project beyond the corner of a first layer as shown in Figure 5. The exact design of the bearing may vary “in conformity with the part being sealed.” Col. 1, lines 63-64.

Note: the method of forming the device is not germane to the issue of patentability of the device itself. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, these limitations have not been given patentable weight.

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7. Claims 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by either U.S. Pat. 2,753,199 to Victor.

Claims 22-23 only require a gasket comprising: a first layer and a second layer or multiple layers disposed one on the other to form a multi-layered gasket having a contour line and a corner, "wherein said second gasket layer comprises a first outer counter line section following a course of the outer contour line of the first gasket layer," and with "a second outer contour line section smoothly adjoining said first outer contour line section of the second gasket area in the area of the corner of the first gasket layer."

Victor discloses a gasket having multiple layers disposed one on the other and having a corner. As shown in Figure 4, the contour of the first gasket follows the course of the contour of the second gasket and the two smoothly adjoin in the area of the corner.

Note: the method of forming the device is not germane to the issue of patentability of the device itself. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, these limitations have not been given patentable weight.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9, 11-19 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of DE 884936 ('936).

AAPA, as found on page 12, fourth full paragraph to page 14, fourth full paragraph, in reference to Figure 2, describes the conventional device (and process) for the production of gasket plate, having a follow-on combination tool (114) with several machining stations (122), a feeding device (106), and a tools for cutting the outer contour lines. Page 2, second paragraph, discloses, "Devices of this type are known from the state of the art."

However, the AAPA does not disclose that the facing outer contour lines of adjacent gasket layers are cut by a single tool using the same cutting edge.

An oral translation of DE '936, reveals that the invention discloses a device (and process) for the production of fittings (a) for furniture. A sheet of metal (b) is feed to a combination tool (see Fig 1), having multiple punches (f,g,h,i). In the final step, a section is cut from the sheet by the punch (i), which cuts the contour lines of adjacent sections using the same cutting edge. It is inherent that a feeding device is provided that moves the section (a) to become fittings through the combination tool by a feed distance equal to the width of one section.

Regarding claims 9, 13, 14, 16, 24, and 25, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the gasket layer of AAPA, by a device (and process) wherein the facing outer contour lines of adjacent gasket layers are cut by a single tool using a the same cutting edge, in light of the teachings of DE '936, in order to reduce waste material between adjacent layers in the prior art.

Regarding claims 11-12, both AAPA and DE '936 disclose a feed cutting station (138, and f, respectively) arranged in front station for cutting the outer contour lines, and transverse to the cutting station.

Regarding claim 15, the angle between the edges of the cutting tool (f) of DE '936 is not disclosed. The cutting angle affects the overall cutting of the contour lines. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the cutting angle 90 degrees, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 17, AAPA discloses gaskets having multiple layers.

Regarding claim 18, AAPA discloses gaskets having multiple layers. However, they do not disclose that the outer contour lines of adjacent layers essentially point symmetric to one another.

Regarding claims 19, and 22-23, the product claimed is inherently produced by the process of AAPA/DE '936. Furthermore, the method of forming the device is not germane to the issue of patentability of the device itself. "[E]ven though product-by-



process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, these limitations have not been given patentable weight.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA/DE '936 in view of either US Patent 4,862,574 to Seidy, US Patent 3,998,300 to Sullivan, or US Patent 3,822,461 to Malmstrom.

AAPA/DE '936 discloses the invention cited above, specifically AAPA discloses gaskets having multiple layers. However, they do not disclose that the outer contour lines of adjacent layers essentially point symmetric to one another.

Siedy, Sullivan, and Malmstrom, all teach fabricating products from sheet material and subsequently cutting along an outer contour line of the adjacent product. Furthermore, the outer contour lines of the adjacent products have been designed to essentially point symmetric to one another. Such a design allows for products having non-linear contour lines to be packed densely without waste material between adjacent products.

Regarding claim 18, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have designed the outer contour lines of adjacent layers to point symmetric to one another, in light of the teachings of either

Siedy, Sullivan, or Malmstrom, in order to provide a greater packing density, without waste between adjacent products.

### ***Response to Arguments***

11. Applicant's arguments filed March 18, 2004 ("Response"), have been fully considered but they are not persuasive.

Applicant argues that the combination of AAPA/DE '936 do not disclose the claimed invention. Response, page 9. It is noted that in the previous Office Action, dated November 14, 2003, that claims 19 and 22-23 were rejected based on AAPA, as well, as the combination of AAPA/DE '936, not merely the combination of AAPA/DE '936, as pointed out by Applicant. See Response, page 11, second paragraph.

Regarding claims 19 and 22-23 (anticipation rejection), AAPA inherently discloses the gasket structure claimed. When applicant states that something is prior art, it is taken as being available as prior art against the claims. Admitted prior art can be used in obviousness rejections. *In re Nomiya*, 509 F.2d 566, 184 USPQ 607, 610 (CCPA 1975) (Figures in the application labeled "prior art" held to be an admission that what was pictured was prior art relative to applicant's invention.). As noted above, product-by-process claims are not construed to be defined by the process. "The patentability of a product does not depend on its method of production. If the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process." *In re Thorpe*,

*supra*. See also the rejections to Yoshida and Victor corroborating the Examiner's rejections based on AAPA.

Regarding the claims rejected as being obvious over the teachings of AAPA and DE '936, Applicant's arguments have previously been presented and addressed. See Applicant's Response dated September 29, 2003, and the Office Action dated November 14, 2003 (addressing Applicant's arguments). In addition, Applicant's arguments regards with respect to the secondary teachings of U.S. Pats. 4,862,574; 3,998,300; and 3,822,461, were also presented and addressed. See *Id.*

AAPA, as embodied in Figure 2, shows at least one free-cutting tool (138) having a corner free shape for free-cutting at least one area out of the starting material, essentially the same design as Applicant's claimed cutting tool. *Cf.* Figure 3 (129'); Attachment B. With regards to the prior art of Figure 2, Applicant discloses, "The lateral separating areas 138 punched out of the sheet metal by the separating punches of the separating station 136 and **the central separating area 140 overlap the free-cutting areas 129 cut out by the free-cutting punches of the free-cutting station 128 such that the outer contour lines cut by the free-cutting punches and by the separating punches adjoin one another smoothly and without any formation of corners.**" *Id.*, pages 13-14. (emphasis added). Thus, AAPA clearly discloses that the tools for cutting the contour lines of the gasket dip into the cutting areas cut by the free-cutting tools.

The only main difference in Applicant's invention and AAPA is that the outer contours lines of adjacent gaskets do not coincide. *Compare* Figure 2 with Figure 3. "[T]he facing outer contour lines of two adjacent gasket layers must be cut by two

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different cutting edges.” Specification, page 2, second paragraph. Therefore, it was the object of Applicant’s invention to provide a device having “the tool for cutting the outer contour lines is designed such that the outer contour lines of the two adjacent gasket layers are cut with the same cutting edge ...” *Id.* fourth paragraph.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Specifically, Applicant contends that DE '936 does not teach or suggest the cutting tool dipping into the cutting area cut by the punching tools in the preceding punching stations.

Furthermore, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In DE '936, there are a number of cutting tools (f,g,h,i). The cutting tools (f,g) corresponds generally to the free-cutting tools (138) of AAPA and free-cut the edge of the parts (a). The other cutting tools (h) punch holes necessary to produce the particular

part (a), but do not correspond to Applicant's invention in any material way. In the last step, the final cutting tools (i) cut along a coinciding (or common) contour line between adjacent parts (a). The cutting tool (i) therefore satisfies the limitation that the "cutting edge of the tool for cutting outer contour lines of the station for cutting outer contour lines," as required by the claims. *Compare* with Specification, page 3, first paragraph (disclosing "only a single cutting edge for each pair of adjacent gaskets"). Furthermore, it is apparent in Fig. 1 of DE '936, that when the cutting tool (i) cuts the contour lines between the adjacent parts (a) it also dips into the area that had been previously cut with the cutting tool (g). See Attachment A. Therefore, the limitation of "the cutting edge of the tool for cutting contour lines of the station for cutting outer contour lines dipping into said free-cutting area during the cutting procedure," as required by the claims is taught by both AAPA and DE '938.

Regarding Applicant's arguments that the prior art of DE '936, U.S. '574, U.S. '300, and U.S. '461 are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant points out that a purpose of the invention, "in the case of the inventive device the facing outer contour lines of two adjacent gasket layers abut directly on one another and so no waste material results between the adjacent layers and the starting material is utilized better." Specification, page 3, third paragraph. While, the prior art cited above, may not necessarily teach gasket layers,

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they do teach and suggest process lines for producing articles in which contour lines of adjacent articles abut directly on one another, in order to save material (i.e., no waste between articles). See '300 Cols. 1-2, lines 65-5; '574 Col 2., lines 34-35; '461 Col. 3, line 14. Thus, the prior art clearly meets the second prong of the *Oetiker* test for being reasonably pertinent to the particular problem, which Applicant faced and thus may be properly relied upon as a basis for rejecting the claims.

Therefore, Examiner maintains the rejections of the claims above.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (703) 305-0240. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter B. Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Eric Compton". The signature is fluid and cursive, with a long horizontal stroke extending from the end.

Eric Compton  
Patent Examiner  
A/U 3726